

REMARKS

Claim Amendments

Applicants presently cancel system claims 17-32 and computer program product claims 33-48, leaving only method claims in the present application. In amending the claims in the present application, Applicants do not concede that the claims as originally filed were not in condition for allowance nor do these cancellations represent a disclaimer of the recited subject matter. Rather, Applicants reserve the right to pursue these cancelled claims in one or more continuation applications. Applicants believe themselves entitled to pursue these claims in additional applications because the cancelled claims are directed to inventions in different statutory categories than are the method claims that remain in this application. Applicants believe they are entitled to have claims directed to inventions in separate statutory categories issued in separate patents.

Applicants additionally amend independent claim 1 in the present application to include all of the limitations of dependent claims 5, 10, and 13. As such, Applicants presently cancel claims 5, 10, and 13 in this Response. Applicants submit that these amendments do not introduce any new matter into the specification, that the rejection of these claims has been overcome, and that the claims are now in condition for allowance.

Claim Rejections – 35 U.S.C. § 102

The Office Action rejects claims 1-4, 7-8, 12, 17-20, 23-24, 28, 33-36, 39-40, and 44 under 35 U.S.C. § 102 as being anticipated by Lee, *et al.* (U.S. Patent No. 6,829,475) (hereafter, 'Lee'). As discussed above, claims 5, 10, 13, and 17-48 are cancelled in this Response. To anticipate Applicants' remaining claims, Lee must disclose and enable each and every element and limitation recited in the claims of the present application. As presently amended, claim 1 now includes limitations previously found in dependent claim 5 of Applicants' original application. The Office Action admits at page 5 that Lee does not disclose the limitations previously found in dependent claim 5 of Applicants' original application. The limitations of former claim 5 are now recited in newly amended claim 1

– so that Lee can no longer be said to disclose all the elements of claim 1. Because Lee does not disclose and enable each and every element and limitation of amended claim 1, Lee does not anticipate claim 1 of the present application. The rejections under 35 U.S.C. § 102 should be withdrawn.

Relations Among Claims

Claims 2-4, 6-9, 11-12, and 14-16 depend respectively from independent claim 1. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Lee does not disclose or enable each and every element of independent claim 1, Lee also does not disclose or enable each and every element of the dependent claims of the present application. As such, claims 2-4, 6-9, 11-12, and 14-16 are also patentable and should be allowed.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 5-6, 9-11, 13-16, 21-22, 25-27, 29-32, 37-38, 41-43, and 45-48 stand rejected for obviousness under 35 U.S.C. § 103 as being unpatentable over a combination of Lee, Ellis, *et al.* (U.S. Patent No. 7,185,355) (hereafter, ‘Ellis’), and Welk, *et al.* (U.S. Patent No. 5,828,585) (hereafter, ‘Welk’). As discussed above, claims 5, 13, and 17-48 are cancelled in this Response, and the limitations previously found in claims 5 and 13 have been incorporated into claim 1 by amendment. The question of whether amended claim 1 in the present application is obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject claim 1 for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of Applicants’ claim

limitations. *Manual of Patent Examining Procedure* § 2142 (citing *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974)). Claim 1 of the present application, as currently amended, recites:

1. A method of providing preferred location specific content for interleaving into broadcast content, the method comprising the steps of:

storing user preferences in user preference records in a content server;

storing location specific content (LSC) in LSC records in the content server, wherein LSC records comprise data elements comprising digital content, content type, target location, duration, relevant date range, and relevant time range;

receiving, from a digital communications network, a location of a user client device;

determining local date and time at the location of the user client device;

storing more than one indication of the location of the user client device and, associated with each such indication of location of the user client device, the local time when the user client device was at the location;

calculating, in dependence upon the stored indications of location and time, a speed of the user client device and a direction of travel of the user client device;

creating preferred location specific content (PLSC) records in the content server, the creating carried out in dependence upon the LSC records, the user preferences, the location of the user client device, and the local date and time at the location of the client device, further comprising creating preferred location specific content (PLSC) records in dependence upon the user preferences, the location of the user client device, the local date and time at the location of the client device, and the speed and direction of travel of the user client device; and

downloading the PLSC records through the digital communications network from the content server to the user client device, wherein the PLSC records to be downloaded include priority, and downloading the PLSC to the user client device further comprises:

downloading the PLSC to the user client device in dependence upon priority; and

excluding priority from the downloaded PLSC records.

As shown below in more detail, the proposed combination of Lee, Ellis, and Welk cannot be used to establish a prima facie case of obviousness because the proposed combination of Lee, Ellis, and Welk does not teach or suggest each and every element of the claims of the present application. The rejection of claim 1 should therefore be withdrawn and the claim should be allowed. Applicants respectfully traverse the rejection and request reconsideration of claim 1.

**The Proposed Combination Of Lee, Ellis, And
Welk Does Not Teach Or Suggest Creating
Preferred Location Specific Content (PLSC)
Records As Claimed In The Present Application**

Claim 1 of the present application is amended to include the following limitations that were previously found in claim 10 of Applicants' original application: downloading the PLSC records through the digital communications network from the content server to the user client device, wherein the PLSC records to be downloaded include priority, and downloading the PLSC to the user client device further comprises downloading the PLSC to the user client device in dependence upon priority, and excluding priority from the downloaded PLSC records. The Office Action at page 7 takes the position that Lee at column 12, lines 13-18 teaches this element of amended claim 1 in the present application. Applicants respectfully note in response, however, that what Lee at column 12, lines 13-18, in fact discloses is:

The gateway 30 further transmits events to the vehicle based on preferences provided by the user in a user profile stored on a stand alone personal computer 206. Such events could be, for example, stock market alerts (i.e., set an alert when a stock reaches a set value), traffic alerts based upon the user's route (notifies of any delays as they happen in real time on the route), email messages, or the like.

That is, Lee at column 12, lines 13-18, discloses transmitting events to the vehicle based on user preferences provided by the user in a user profile. Lee's transmitting events to the vehicle based on user preferences provided by the user in a user profile, however, does not teach or suggest downloading PLSC records as claimed in the present application because Lee does not teach or suggest downloading records in dependence upon priority. Lee merely discloses event transmission that is based on user preferences – not priority. Lee's user preferences only determine what events are transmitted. Lee's user preferences, however, are not used to establish priority between events to be transmitted. In contrast, Applicants' claims recite a method of providing preferred location specific content that makes use of both user preferences and priority. Because Lee does not teach or suggest downloading records in dependence upon priority, Lee cannot possibly teach or suggest downloading the PLSC records through the digital

communications network from the content server to the user client device, wherein the PLSC records to be downloaded include priority, and downloading the PLSC to the user client device further comprises downloading the PLSC to the user client device in dependence upon priority, and excluding priority from the downloaded PLSC records as claimed in the present application. The cited combination of Lee, Ellis, and Welk therefore does not teach or suggest each and every element and limitation of Applicants' claim, and the combination of Lee, Ellis, and Welk cannot be used to establish a *prima facie* case of obviousness against Applicants' claims within the meaning of 35 U.S.C. § 103. The rejections under 35 U.S.C. § 103 should therefore be withdrawn.

**The Office Action Does Not Examine
Applicants' Claims Pursuant To *Graham***

In addition to the fact that the Office Action has not established a *prima facie* of obviousness there is another reason that the rejection of claim 1 should be withdrawn: The Office Action does not examine Applicants' claims in light of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The question of whether Applicants' claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007); *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). "To facilitate review, this analysis should be made explicit." *KSR*, slip op. at 14 (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). That is, the Office Action must make explicit an analysis of the factual inquiries set forth in *Graham*. In present case, however, the Office Action does not even mention the factual inquiries set forth in *Graham*. As such, the rejections of Applicants' claims under 35 U.S.C. § 103 are improper and should be withdrawn.

Relations Among Claims

Claims 2-4, 6-9, 11-12, and 14-16 depend from independent claim 1. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Lee, Ellis, and Welk does not teach or suggest each and

every element of independent claim 1, the combination of Lee, Ellis, and Welk also does not teach or suggest each and every element of the dependent claims of the present application. As such, claims 2-4, 6-9, 11-12, and 14-16 are also patentable and should be allowed.

Conclusion

Claims 1-4, 7-8, and 12 stand rejected under 35 U.S.C. § 102 as being anticipated by Lee. Lee does not disclose each and every element of Applicants' claims. Lee therefore does not anticipate Applicants' claims. Claims 1-4, 7-8, and 12 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-4, 7-8, and 12.

Claims 6, 9, 11, and 14-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over a combination of Lee, Ellis, and Welk. The combination of Lee, Ellis, and Welk does not teach or suggest each and every element and limitation of claims 6, 9, 11, and 14-16. The combination of Lee, Ellis, and Welk therefore cannot be used to establish a prima facie case of obviousness against claims 6, 9, 11, and 14-16 within the meaning of 35 U.S.C. § 103. Applicants respectfully request reconsideration of claims 6, 9, 11, and 14-16.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,



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